

REMARKS

I. Summary of Office Action

Claims 1-58 are pending in this application.

Claims 20, 39, 42, and 50-53 are rejected under the judicially created doctrine of obviousness-type double patenting over claims 13-17 and 28 of Alexander et al. U.S. Patent No. 6,177,931 (hereinafter "Alexander").

Claims 1-19, 29, 30, and 57 are rejected under 35 U.S.C. § 102(e) as being anticipated by Klosterman et al. U.S. Patent No. 5,940,073 (hereinafter "Klosterman").

Claims 20-28, 31-56, and 58 are rejected under 35 U.S.C. § 102(e) as being anticipated by Schein et al. U.S. Patent Application Pub. 2003/0005445 (hereinafter "Schein").

II. Summary of Applicants' Reply

Applicants have amended claims 1, 2, 6-11, 14, 20, 24-29, 32, 39, 57, and 58 to more particularly define the invention. Applicants have also added new claims 59-61. No new matter has been added, and the proposed amendments are fully supported by applicants' specification as originally filed.

The rejection of applicants' claims under 35 U.S.C. § 102(e) is respectfully traversed.

III.        Summary of Telephonic Interview

The undersigned and the undersigned's colleague, Michael Chasan (Reg. No. 54,026), conducted a telephonic interview with the Examiner and his supervisor, Chris Grant, on March 21, 2007. During the interview, applicants discussed their claimed invention and the current 35 U.S.C. § 102(e) rejections over Klosterman and Schein.

Applicants argued that neither reference showed or suggested applicants' claimed feature of combining a portion of received advertisement information with a portion of the stored television schedule information to form a modified advertisement and then displaying this modified advertisement in a display screen. Applicants wish to thank the Examiner and his supervisor for the courtesies extended during the interview.

IV.        The Nonstatutory Double Patenting Rejection

The Examiner has rejected claims 20, 39, 42, 50-53 under the doctrine of obviousness-type double patenting as being unpatentable over claims 13-17 and 28 of Alexander.

Applicants respectfully request that the Examiner maintain the double patenting rejection so long as any pending claims in the present application are not patentably distinct

from one or more claims in Alexander. Applicants will file a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(b, c) when the application is otherwise in condition for allowance.

V. The Rejection of Independent Claims 1 and 57

The Office Action contends that Klosterman shows every feature of applicants' independent claims 1 and 57. See Office Action, pages 2 and 4. Applicants respectfully disagree.

Applicants independent claims 1 and 57, as amended, are generally directed toward a method and computer readable medium for displaying an advertisement in an electronic program guide (EPG). Television schedule information is stored in a database. Advertisement information is received, and a portion of the received advertisement information is modified, at a user equipment, to include a portion of the stored television schedule information to form a modified advertisement. A plurality of television schedule listings are displayed in a first area of a display screen, and the modified advertisement is displayed in a second area of the display screen.

Klosterman describes, *inter alia*, an enhanced program schedule guide with information regions for displaying additional information, such as "advertising and promotional

messages for products or programs." See Klosterman, col. 1, line 64 - col. 2, line 2. In some embodiments of Klosterman, the program guide and information regions may also include other information, such as news, sports, and weather. See Klosterman, col. 2, line 17-21.

Although Klosterman's information regions may include advertising information and other information, applicants' independent claims 1 and 57 patentably improve upon the teachings of Klosterman at least by "modifying, at the user equipment, a portion of the received advertising information to include a portion of the stored television schedule information to form a modified advertisement." This modified advertisement is then displayed in a screen with a plurality of television schedule listings in a separate area.

Applicants' claimed invention may provide the advantage of allowing an advertiser or service provider to transmit a single (e.g., generic) advertisement to multiple users and then combining the advertisement with stored television schedule information to create a modified, custom advertisement at the user equipment. See applicants' Abstract and specification ¶¶ 0321-0340. This enhanced advertisement may then be displayed to the user to customize the user's advertisement viewing experience.

For example, applicants' specification teaches that viewer profile information may be used to provide customized advertisements to the viewer. See specification ¶¶ 0321-0340. One way to create a customized advertisement is to create a personalized "overlay message to an advertisement" (specification, ¶ 0323). This overlay message can be triggered when the advertisement is to be displayed and overlaid on top of the advertisement. *Id.*

In addition to modifying the visual appearance of an advertisement, applicants' specification teaches of modifying advertisements in other ways. For example, an advertisement may be "linked to the time and channel of the program in RAM so the viewer can watch or record the program automatically" (specification, ¶ 0034). Therefore, the EPG may link the advertisement to information from the television schedule database. Each advertisement may also be associated with "multiple levels of information" (specification, ¶ 0277). First level information may include the advertisement itself (e.g., graphics that are presented on the screen with no user action). See specification, ¶ 0278. Second level information may include secondary advertisement information presented in an information box or window after user selection of an advertisement. Third level information may include multiple pages of detailed advertisement information. See

specification, ¶ 0279. Any of the foregoing levels of information may modified by the EPG to customize the presentation of an advertisement.

Advertisements "may also be assigned theme codes, profile codes, and other selection intelligence" (specification, ¶ 0331). Profile codes may be used in conjunction with viewer profile information to further "customize the presentation and/or scheduling of telecast advertisements" (specification, ¶ 0323). Since the EPG knows the geographic location of the viewer, advertisements may be personalized, for example, with a custom overlay message depending on the user's location. *Id.*

For the foregoing reasons, applicants submit that independent claims 1 and 57 are allowable over Klosterman. Dependent claims 2-19, which include all the limitations of independent claim 1, are allowable for at least the same reason. Applicants respectfully request, therefore, that the rejection of these claims under 35 U.S.C. § 102(e) be withdrawn.

VI.        The Rejection of Independent Claims 20, 39, and 58

Applicants' independent claims 20, 39, and 58, as amended, are generally directed toward a method, system, and computer readable medium for modifying an advertisement in an

EPG. Television schedule information is stored in a first database. Advertisement information is stored in a second database. A portion of the television schedule information is overlaid onto a portion of the advertisement information to form a modified advertisement (claims 20 and 58), or a portion of the information stored in the second database is modified to include a portion of the television schedule information to form an updated advertisement (claim 39). The modified or updated advertisement is then displayed in a second area of a display screen while a plurality of television schedule listings are displayed in a first area of the display screen.

Schein refers to, *inter alia*, systems and methods for "directly linking television viewers with . . . advertisers." (See Schein, ¶ 0007). The Office Action contends that Schein shows all of applicants' claimed features recited in independent claims 20, 39, and 59. See Office Action, pp. 7-9. Applicants respectfully disagree.

While Schein shows directly linking viewers with advertisers, applicants respectfully submit that applicants' claimed invention patentably improves upon the teachings of Schein. As described above, applicants' claimed invention forms a modified or updated advertisement by overlaying program schedule information onto advertisement information or modifying advertisement information to include television

schedule information. This modified or updated advertisement is then displayed in a second area of a display screen while a plurality of television schedule listing are displayed in a first area of the display screen. For example, a generic advertisement for a particular television show may be customized by including an overlay with the local television channel and time the show is to be broadcast to the user. In this way, the user is presented with a personalized advertisement including television schedule information stored locally in a database. See, e.g., applicants' specification, ¶¶ 321 - 331.

Accordingly, applicants submit that independent claims 20, 39, and 58 are allowable over Schein. Dependent claims 21-38 and 40-56, which include all the limitations of independent claims 20 and 39, respectively, are allowable for at least the same reason. Applicants respectfully request, therefore, that the rejection of these claims under 35 U.S.C. § 102(e) be withdrawn.

VII. New Dependent Claims 59-61

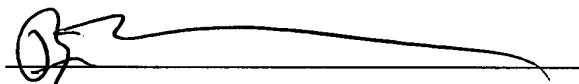
New dependent claims 59-61 depend from independent claim 1. These claims specify particular ways in which an advertisement may be modified to include television schedule information. For example, claim 59 recites that the

television schedule information is overlaid onto the advertisement information. Claim 60 recites that a text portion of the received advertisement information is replaced with the television schedule information, and claim 61 recites that a graphic portion of the received advertisement information is replaced with the television schedule information. Applicants submit that dependent claims 59-61 are allowable over the prior art of record for at least the same reasons as independent claim 1.

VIII. Conclusion

For the foregoing reasons, applicants submit that claims 1-61 are allowable over the prior art of record. This application is therefore in condition for allowance. Accordingly, prompt consideration and allowance of this application are respectfully requested.

Respectfully submitted,



Brian E. Mack  
Registration No. 57,189  
Agent for Applicants  
FISH & NEAVE IP GROUP  
ROPES & GRAY LLP  
Customer No. 1473  
1211 Avenue of the Americas  
New York, New York 10036-8704  
(212) 596-9000